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Name of Attorney Registration No.
Signature of Attorney



P&G Case 8160

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of :
MICHAEL L. VATTER : Confirmation No. 8449
Serial No. 09/902,321 : Group Art Unit 1619
Filed July 10, 2001 : Examiner A. Berman
For Cosmetic Compositions

BRIEF ON APPEALS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed, pursuant to 37 C.F.R. 1.192(a), is Appellant's brief on Appeal for the above application. The Brief is being forwarded in triplicate.

Please charge the fee of \$320.00 pursuant to 37 C.F.R. 1.17(c) to Deposit Account No. 16-2480 for the filing of the brief in support of an appeal. The Commissioner is also authorized to charge any additional fees with may be required to this account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By

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Date: July 17, 2003

Customer No. 27752

(BriefonAppealTrans.doc)
(Last Revised 4/3/2003)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/902,321
Applicant(s) : MICHAEL L. VATTER
Filed : July 10, 2001
Title : Cosmetic Compositions

TC/A.U. : 1619
Examiner : A. Berman
Conf. No. : 8449
Docket No. : 8160

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

This Appeal Brief is submitted in support of the Notice of Appeal filed on February 18, 2003, setting a two-month period for response. A petition to extend the period for response three months is submitted herewith.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio. The Inventor Michael Lee Vatter assigned his interest to The Procter & Gamble Company which was recorded on September 10, 2001, reel 12155, frame 670.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, or known to Appellant's legal representative that will directly affect, will be directly affected by, or will have a bearing on the Board's decision in the present appeal.

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STATUS OF CLAIMS

Claims 1-14 are pending and stand rejected. A copy of these claims, which are being appealed, appear in the Appendix.

STATUS OF AMENDMENTS

No amendments were submitted by Appellant subsequent to the final Official Action.

SUMMARY OF THE INVENTION

The present invention relates to a stable multiphase emulsion composition, comprising:

- A.) a continuous phase, comprising:
 - i.) an emulsifying crosslinked siloxane elastomer; and
 - ii.) a solvent for the emulsifying crosslinked siloxane elastomer;
- B.) at least one discontinuous phase, comprising:
 - i.) solid particles

wherein the discontinuous phase has a droplet size distribution range of from about 0.1 microns to about 100 microns and wherein the particles are uniformly distributed on the skin independent of skin topography. Applicants have surprisingly found that these compositions provide a natural appearance to the skin upon application since they are formulated such that agglomeration of the pigment upon application to the skin is minimized.

ISSUES

Appellant presents the following issues for consideration on appeal:

- I. Under 35 USC §103, do the general disclosures of the cited reference provide a skilled artisan with the motivation necessary to arrive at Appellants' claimed cosmetic composition, particularly instant claims 1-10 and 12-14, when the reference fails to teach or suggest Appellant's claimed droplet size distribution range and the delivery of solid particles via the discontinuous phase of an emulsion composition?
- II. Under 35 USC §103, do the general disclosures of the cited references provide a skilled artisan with the motivation necessary to arrive at instant claim 11 when the reference fails to disclose the requisite limitations of Applicants' invention that deal with droplet size distribution and Applicants' solid particles being dispersed within the discontinuous phase?

GROUPING OF CLAIMS

Claims 1-14 stand or fall together.

ARGUMENTS

In the Office Action dated November 20, 2002, the Office rejected Claims 1-10 and 12-14 as being unpatentable over US 5,412,004, Tachibana et al. (hereinafter "Tachibana"). The Office maintains that the limitations currently claimed by Appellants are all taught with the exception of the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer, and the amount of air contained in the composition. The Office, however, reasons that it is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. Thus, the Office believes it to be within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes. Additionally, Claim 11 has been rejected under 35 USC §103(a) as being unpatentable over Tachibana as applied to claims 1-10 and 12-14 and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Co., New York (1981), pages 121, 385, 434, and 686 (hereafter "Hawley"). The Office believes that Hawley teaches the preservatives that are lacking in Tachibana's disclosure and therefore opines that it would have been obvious to one of ordinary skill in the art at the time of the invention to add any one of the preservatives disclosed in Hawley to the composition of Tachibana for their known antimicrobial effects.

In view of the foregoing, the Office is of the opinion that the claimed invention is clearly obvious in view of the prior art.

For the reasons that will be set forth below, Appellant submits that Claims 1-14 are nonobvious over and patentably distinct from the cited references. Thus, the Board should reverse the Examiner's rejections. Accordingly, the favorable action by the Board is respectfully requested.

- I. Claims 1-10 and 12-14 are not obvious in view of the cited references under 35 USC §103(a) because the references fail to teach or suggest Appellant's particle distribution in the discontinuous phase wherein the droplet size distribution range is from about 0.1 microns to about 100 microns.**

Appellants respectfully submit that the claimed invention would not have been obvious over the cited references. Tachibana discloses a silicone polymer, a paste-like composition prepared by kneading the silicone polymer and a silicone oil under a shearing force, and a water-

in-oil type cosmetic composition comprising the paste-like silicone composition as an oil phase component. In particular, Tachibana discloses a silicone polymer that is prepared by the additional polymerization of components comprising an $R^1_a R^2_b H_c SiO_{(4-a-b-c)/2}$ (1) or $R^1_f H_g SiO_{(4-f-g)/2}$ and a polyoxyalkylene $C_m H_{2m-1} O (C_2 H_4 O)_h (C_3 H_6 O)_i C_m H_{2m-1}$ or an organopolysilxane $R^1_j R^4_k SiO_{(4-j-k)/2}$ (B), including (1) or (A) as an essential component. The reference, however, fails to teach or suggest a composition as Appellants currently claim that includes a solid particle-containing discontinuous phase wherein the discontinuous phase has a droplet size distribution range of from about 0.1 microns to about 100 microns. Moreover, the reference fails to teach or suggest that such particles are uniformly distributed on the skin independent of skin topography. Appellants have found that the solid particles, when in the discontinuous phase, are dispersed within and/or at the droplet interface of the emulsion system such that capillary-induced agglomeration of the particles is confined within the space or volume occupied by the droplet, thereby providing a more even distribution of the broad range of particles on skin. Additionally, the droplets serve as a barrier preventing agglomeration as a result of application shear which provides a more uniform look upon application. These principles/observations are not disclosed expressly or implicitly in the Tachibana reference. In fact, Tachibana fails to teach or suggest the delivery of powder or pigmented solids via the discontinuous phase of an emulsion composition. The Office identifies that Tachibana discloses solids selected from the group consisting of sugars, sugar alcohols and inorganic salts for use in the water phase of its composition. Appellants respectfully submit that Tachibana's solids are contrary to the presently claimed invention because Tachibana's water-soluble actives would prevent uniform deposition of such particles on the skin. Solids, such as those taught by Appellants' invention, can be identified as those that not only exhibit an average particle size less than 20 microns but are also insoluble in order to provide optimal delivery to the skin. Further, Tachibana would fall short of achieving Appellant's desired deposition pattern since Tachibana fails to teach or suggest the distribution of the solid particles in the discontinuous phase within and/or at the droplet interface of the emulsion system as presently claimed. Appellants respectfully submit that the particle distribution plays a significant role in achieving optimal aesthetic and functional delivery performance. As previously stated, Appellants' invention shows minimal agglomeration of the solid particles on skin helping to enhance the overall look of the composition on skin. One skilled in the art would appreciate the distinction of dispersing the particles in a particular phase and would understand the significance of Appellant's claims for achieving a desired sheer independent discontinuous deposition on skin. Appellants respectfully submit that one skilled in the art reading Tachibana would not appreciate the aesthetic and functional attributes achieved by Appellants' claimed invention. Instead, a skilled artisan

reading Tachibana would find that if cosmetic powders are used, they are to be deposited solely in the external, oil phase resulting in a shear dependent continuous deposition.

The Office believes the prior art to inherently exhibit the same properties as that which is presently claimed. Appellants respectfully submit that the Office has rejected the aforementioned claims under an assertion of obviousness yet relies on a rationale of inherency. Respectfully, it has been well settled that inherency is an anticipation rationale and when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. *See, Ex Parte Schriker*, USPTO, Board of Patent Appeals and Interferences, No. 1996-2414, Decided June 7, 2000; 56 USPQ2d 1723, 1725. Moreover, the present invention is distinguishable from the reference such that the reference cannot expressly or inherently exhibit the same properties as that which is presently claimed. Appellants teach that pigmented powders must be deposited in the internal, discontinuous, water phase as opposed to the external, continuous, oil phase exemplified by Tachibana. Furthermore, that which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. *In re Shetty*, 566 F.2d 81, 195 USPQ 753, 757 (CCPA 1977). It is clear that one reading Tachibana would not have the knowledge to appreciate the effective aesthetics offered and discovered by Appellants' invention. Based on the foregoing, a rejection under 35 USC §103(a) is, therefore, improper and should respectfully be withdrawn.

II. Claim 11 is not obvious in view of the cited references under 35 USC §103(a) because the references fail to teach or suggest Appellant's particle distribution in the discontinuous phase wherein the droplet size distribution range is from about 0.1 microns to about 100 microns.

Claim 11 has been rejected under 35 USC §103(a) as being unpatentable over Tachibana as applied to claims 1-10 and 12-14 and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Co., New York (1981), pages 121, 385, 434, and 686 (hereafter "Hawley"). The Office believes that Hawley teaches the preservatives that are lacking in Tachibana's disclosure. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to add any one of the preservatives disclosed in Hawley to the composition of Tachibana for their known antimicrobial effects.

As explained above relative to Tachibana, the reference fails to disclose the requisite limitations of Appellants' invention that deal with droplet size distribution and Appellants' solid particles being dispersed within the discontinuous phase. Therefore, the mere addition of Hawley's disclosure of commonly used preservatives fails to remedy this shortcoming. Tachibana still fails to teach or suggest Appellants' presently claimed emulsion system which

provides minimized agglomeration and even distribution of the broad range particles on skin for an aesthetically pleasing, natural appearance. Thus, Appellants respectfully assert that this reference's disclosure of well known preservatives when viewed in combination with Tachibana would not have rendered Appellants' invention obvious since none of the benefits of the claimed composition are taught, suggested, or even recognized by either reference. Even if one were to hypothetically combine the two references, one would still fall short of Appellants' presently claimed invention because one would not know or understand the necessity of dispersing Appellants' solids within the discontinuous droplet phase instead of the external, continuous, oil phase in order to achieve such beneficial looks met by the instant claims.

In view of the cited references, one skilled in the art would only fall short or completely fail to arrive at the presently claimed invention. There is no motivation or desire to arrive at the specifics necessary to obviate Appellant's invention. In determining obviousness, "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and the obviousness of making the combination." *Lindeman Maschinenfabrick GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984); *Maize*, 5 USPQ 1788, 1793 (Fed. Cir. 1988). The fact that the references relate to the same area of technology is insufficient. *In re Geiger*, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *See, SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Based on the foregoing, a rejection under 35 USC §103(a) is, therefore, improper and should respectfully be withdrawn.

SUMMARY

Given the references' failure to teach or suggest the specifically claimed multiphase emulsion composition wherein the particles are contained solely in the discontinuous phase and wherein the discontinuous phase has a droplet size distribution range of from about 0.1 microns to about 100 microns and wherein the particles are uniformly distributed on the skin independent of skin topography, it would not have been obvious to a skilled artisan aware of the references to arrive at Appellant's presently claimed invention. Appellant respectfully submits that the Examiner's rejection of Claims 1-14 as being unpatentably obvious under 35 USC §103(a) is

improper. Reversals by the Board of the Examiner's rejections are, therefore, respectfully requested.

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July 17, 2003
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